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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,552	01/21/2004	Jeff Kirsner	HALB:020D1	2843

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EXAMINER ,
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KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1712

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09/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/761,552	Applicant(s) KIRSNER ET AL.	
	Examiner Timothy J. Kugel	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24,33,34 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,33,34 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 24, 33, 34 and 37-39 are pending as amended on 27 July 2007, claims 1-23, 25-32, 35, 36 and 40-44 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.
3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 July 2007 has been entered.

### ***Response to Amendment and Arguments***

4. Applicant's amendment canceling claims 35 and 36, filed 27 July 2007, renders the following moot:

The objection to claims 35 and 36 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn.

The rejection of claims 35 and 36 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

The provisional rejection of claims 35 and 36 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 195, 240 and 285 of copending Application 10/933,560 has been withdrawn.

The provisional rejection of claims 35 and 36 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/633,703, filed since the mailing date of the previous Office action has been withdrawn.

The provisional rejection of claims 35 and 36 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/633,704, filed since the mailing date of the previous Office action has been withdrawn.

The provisional rejection of claims 35 and 36 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/634,008, filed since the mailing date of the previous Office action has been withdrawn.

The rejection of claims 35 and 36 under 35 USC 102(b) as being anticipated by US Patent 5,691,281 (Ashjian hereinafter) has been withdrawn.

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5. Applicant's terminal disclaimers, filed 27 July 2007, have been fully considered and are proper.

The provisional rejection of claims 24 and 33-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 195, 240 and 285 of copending Application 10/933,560 has been withdrawn.

The provisional rejection of claims 24 and 33-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/633,703 has been withdrawn.

The provisional rejection of claims 24 and 33-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/633,704 has been withdrawn.

The provisional rejection of claims 24 and 33-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claim 3 of copending Application 11/634,008 has been withdrawn.

6. Applicant's amendment to independent claim 24, filed 27 July 2007, specifically providing antecedent basis for the term 'the blend', overcomes the following:

The rejection of claims 24, 33, 34 and 37-39 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

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7. Applicant's amendment to independent claim 24, filed 27 July 2007, specifically requiring the esters to be present at from at least about 46 weight percent, although unsupported by the original disclosure or claims—see below—overcomes the following

The rejection of claims 24, 33, 34 and 37-39 under 35 USC 102(b) as being anticipated by Ashjian has been withdrawn.

8. Applicant's arguments, filed 27 July 2007, have been fully considered but they are not persuasive.

Applicant argues that Ashjian makes only one reference to esters and only discloses that such *may* be added to the blend of olefins; however, this disclosed embodiment is a sufficient teaching to read on the instant claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 USC 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 24, 33, 34 and 37-39 are rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The amended endpoints of the ranges of percentages of the component of the continuous phase of the invert emulsion find no support in the original disclosure or claims. This is a new matter rejection.

***Claim Rejections - 35 USC § 102 or 35 USC § 103***

The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24, 33, 34 and 37-39 are rejected under 35 USC § 102(b) as being anticipated or, in the alternative, under 35 USC § 103(a) as being unpatentable over Ashjian.

Ashjian teaches a method of drilling a wellbore comprising circulating a drilling mud comprising an invert emulsion (Column 1 Lines 5-65) comprising a base composed of a blend of 5 to 80 weight percent (Column 6 Lines 23-27) of a long chain isomerized olefin of at least 18 carbon atoms (Column 3 Lines 26-41) and 50 to 90 weight percent of n-paraffins, iso-paraffins and cycloparaffins of 10 to 18 carbon atoms (Column 3 Lines 51-59 and Column 6 Line 38 – Column 7 Line 6) which may further comprise esters (Column 6 Lines 28-37) which, by difference, may comprise up to 45 weight percent of the blend.

Ashjian does not disclose expressly esters being present at from at least about 46 weight percent of the blend; however, Ashjian reads on the instant claims because

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the instant claims use the term “about at least 46 weight percent”—which could be construed to include 45 weight percent—and because it has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a *prima facie* rejection is properly established when the difference in the range or value is minor. *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). If there is any difference between the product of Ashjian and the product of the instant claims the difference would have been minor and obvious.

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) and *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2007/0078060	04-2007	Kirsner et al.
US 2007/0078061	04-2007	Kirsner et al.
US 2007/0078062	04-2007	Kirsner et al.
US 2007/0082822	04-2007	Kirsner et al.



12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Timothy J. Kugel/  
Patent Examiner, AU 1712